

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID W. DEATON
and ROBERT SCOTT WOOD

Appeal No. 2004-0786
Application No. 08/935,116

HEARD: August 18, 2004

Before JERRY SMITH, LEVY, and BLANKENSHIP, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 8-39, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a system, method and database for processing transactions. An understanding of the

invention can be derived from a reading of exemplary claims 8 and 33, which are reproduced as follows:

8. A system for accumulating customer transaction data at the point-of-sale in a retail establishment and for effectuating customer promotion on the basis thereof, comprising:

a terminal for entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction;

means for allowing entry of customer transaction data;
a processor and a memory responsive to said terminal and said means for allowing entry for creating a database for a plurality of the retail establishment's customer's transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and

circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer, said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion.

33. A computer implemented customer database comprising stored transaction data from prior point-of-sale transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer, said transaction data including:

dollar amount of purchases and time period.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Goldman et al. (Goldman)	Re. 30, 580	Apr. 14, 1981
Creekmore	4,109,238	Aug. 22, 1978
Tai	4,908,761	Mar. 13, 1990
Off et al. (Off)	4,910,672	Mar. 20, 1990
Bigari	5,010,485	Apr. 23, 1991
Deaton et al. (Deaton '010)	5,201,010	Apr. 6, 1993
Deaton et al. (Deaton '196)	5,305,196	Apr. 19, 1994
Deaton et al. (Deaton '560)	5,592,560	Jan. 7, 1997

Claims 33-39 stand rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

Claims 8, 9, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Creekmore.

Claims 33-39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Goldman.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off.

Claims 10, 11 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off and Tai.

Claims 17-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off, Tai and Bigari.

Claims 8, 9, 12 and 13 stand rejected under the doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent 5,305,196.

Claims 10, 11 and 14 stand rejected under the doctrine of obviousness-type double patenting over claims 18 and 26 of U.S. Patent 5,201,010 in view of Tai.

Claims 17-32 stand rejected under the doctrine of obviousness-type double patenting over claims 1 and 3 of U.S. Patent 5,592,560.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer¹ (Paper No. 35, mailed April 19, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief² (Paper No. 25, filed February 4, 2002) reply brief (Paper No. 28, filed April 29, 2002) and supplemental reply brief³ (Paper No. 37, filed June 26, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

¹ Supplemental examiner's answer.

² Substitute appeal brief.

³ Response to the supplemental examiner's answer.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of non-statutory subject matter, anticipation, obviousness and obviousness-type double patenting, relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we affirm-in-part, and enter a new ground of rejection, under 37 CFR § 1.196(b), of claim 33 under 35 U.S.C. § 102.

We begin with the rejection of claims 33-39 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. The examiner's position (answer, page 2) is that the claims are drawn to non-functional descriptive matter, and that the invention recites stored transaction data which does not produce a useful, concrete or tangible result. Appellants assert (brief, page 35) that the claims define a statutory novel composition of matter whose utility resides in the ability of the computer system to retrieve representations of the data and the associations between

the data stored therein to perform the credit verifications and marketing functions disclosed in the application. Appellants add that the computer implemented customer database is clearly useful to the merchant, and its disclosed uses are useful, concrete and tangible, being for credit determination and targeted customer marketing.

From our review of claim 33, we find that the claim is directed to a computer implemented customer database having stored transaction data from prior point-of-sale transactions for a plurality of customers. The claim additionally recites that data regarding a customer's prior transactions are stored in association with an identification of the customer and that the transaction data includes the dollar amount of purchases and time period. From our analysis of the language of claim 33, we find that the computer implemented customer database is useful to a merchant, as the database has stored customer data. We additionally find that the database with customer transaction information is tangible as it contains specific customer transaction information. Moreover, we find that the storing of the dollar amount of purchases and time period is concrete, as the dollar amounts of different transactions for each customer are stored. From all of the above, we find independent claim 33

to be statutory under 35 U.S.C. § 101. Turning to independent claim 34, we find claim 34 to be statutory for the same reasons as claim 33. Accordingly, the rejection of claims 33-39 under 35 U.S.C. § 101 as being drawn to descriptive, non-functional subject matter is reversed.

We turn next to the rejection of claims 8, 9, 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by Creekmore. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgird v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939))

(internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

The examiner's position is set forth on pages 2 and 3 of the answer.

Appellants assert (brief, page 11) that "Creekmore does not disclose a system for entering unique customer identification codes from customer identification presented at the point-of-sale and for accumulating transaction data at the point-of-sale, as claimed." It is argued that because the terminal 13 of Creekmore is located near the checkout lanes of a grocery store, it is not located at the point of sale. It is further argued (brief, page 14) that the data entry of columns 5 and 6 of Creekmore refers to entering customer identification codes, and does not relate to the entry of transaction data as recited in claim 8.

From our review of Creekmore's disclosure, we find that Creekmore discloses (col. 5, lines 18-28) that "the input terminal 13 . . . may be positioned at any convenient point-of-use location such as a location near the checkout lanes of a grocery store. When a customer desires to undertake a particular checking function, such as paying presently-unknown amount for the purchase of groceries, he inserts his identification card 25 into a slot 26 provided on the side 27 of the input terminal. The customer next places a blank check 28 face-down on the check tray 29, and then slides the check tray into the opening provided in the front face 30 of the input terminal." Creekmore further discloses (col. 5, lines 57 and 58) that in this example, it is

presumed that a customer has not passed through the checkout lane of the store.

From the disclosure of Creekmore, we agree with appellants that a customer of Creekmore will first go to the check verification terminal for check approval, and then go to the checkout. Thus, Creekmore does not disclose that the terminal for entering the unique customer codes is located at the point-of-sale, as required by claim 8. We agree with the examiner that Creekmore discloses storing customer data relating to prior transactions, because the number of checks cashed within a particular period and their dollar amounts relates to the customer's prior transactions (col. 7, lines 19-21 and col. 7, lines 64-68 and col. 10, lines 48-56). In addition, Creekmore discloses that the information relating to the dollar amount of the check is entered into the terminal by the user (col. 3, lines 6-10 and col. 10, lines 52 and 53), and that a nightly update routine is used to generate various reports and records, and various statistical reports as desired (col. 10, lines 48-56). However, we are not persuaded by the examiner's assertion (answer, page 8) that point-of-use is equivalent to point-of-sale. Firstly, Creekmore's disclosure that the terminal is near the checkout and that the customer goes to the checkout after

obtaining check approval makes clear that the terminal is not at the point-of-sale. Secondly, the examiner's arguments regarding equivalence are misplaced as the rejection is not based upon 35 U.S.C.

§ 103(a). By asserting equivalence, the examiner in effect is taking the position that the reference does not teach the claimed subject matter, but that an artisan would have recognized the equivalence between the disclosure of Creekmore and the claim, and considered the substitution to have been obvious. From all of the above, we conclude that Creekmore does not anticipate claim 8. Accordingly, the rejection of claim 8 under 35 U.S.C. § 102(b) is reversed. In addition, for the same reasons, we reverse the rejection of independent claim 9, as well as dependent claims 12 and 13.

We turn next to the rejection of claims 33-39 as being anticipated by Goldman. The examiner's position is set forth on pages 3 and 4 of the answer. Appellants assert (brief, page 15) that with respect to claim 33, "Goldman et al. does not disclose a computer implemented customer database comprising stored transaction data wherein the transaction data includes 'dollar amount of purchases and time period' as recited in claim 33."

From our review of Goldman we find that although Goldman discloses (col. 5, lines 24-54) a table providing input to the cashier as to whether the customer's check should be accepted, we find that Goldman does not disclose that the stored transaction data includes the dollar amount of purchases. We agree with the examiner that Goldman discloses (in the table of column 5) the cashing of a number of checks during a current period (col. 11, lines 56-64). However, claim 33 requires more than the storing of data relating to the time period of prior transactions. The claim requires that the dollar amount of the transactions are stored in the customer database. We do not agree with the examiner that a worthless check having no value is a disclosure of a dollar amount of the transaction. A worthless check has no dollar amount of value, even if the transaction had a dollar amount. Because Goldman does not disclose storing the dollar amount of prior transactions in the customer database, we find that Goldman does not anticipate claim 33. Accordingly, the rejection of claim 33 under 35 U.S.C. § 102(b) is reversed.

In addition, because independent claim 34 also requires that the stored transaction data includes the dollar amount of the transaction, the rejection of claim 34, and claims 35-39, dependent therefrom, under 35 U.S.C. § 102(b) is reversed.

We turn next to the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off. Appellants assert (brief, page 18) that claims 15 and 16 stand or fall together. Accordingly, we select claim 15 as representative of the group. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying

with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 4 and 5) is that Creekmore does not disclose:

Responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer.

To make up for this deficiency of Creekmore, the examiner turns to Off for a teaching of these features, relying upon col. 9, lines 15-60 of Off. Appellants assert (brief, page 20) that because Off is not directed to a credit pre-verification system,

it would not have been obvious to have combined the teachings of Off with the teachings of Creekmore. It is further asserted (brief, page 21) that even if combined the combination would not result in the claimed subject matter. Appellants reiterate that Creekmore does not teach or disclose entering a unique identification code for a customer at a point-of-sale terminal, and assert (brief, page 21) "Creekmore does not teach or suggest entering into said terminal transaction data relating to the customers shopping transactions." It is argued (id.) that Off only teaches or suggests entering at a point-of-sale terminal transaction data relating to a current shopping transaction, and does not teach entering transaction data relating to the customer's prior shopping transactions. It is further argued (brief, page 23) that Off teaches away from the claimed invention because Off does not teach entering into a point-of-sale terminal a unique identification code for a customer, and therefore does not teach or suggest responding to an entry, during a current transaction, of a unique code for a customer, as recited in claim 15. It is additionally argued (brief, page 24) that Off is directed to detecting triggering products in a customer's current shopping transaction, and does not involve analyzing prior

shopping transactions or the identification of any particular customer.

From our review of Off, we find that Off is directed to a point-of-sale system for providing coupons or discounts to customers. We agree with the examiner that an artisan would have been motivated to combine the system of Off with the system of Creekmore, in order to provide a coupon generating system at the point-of-sale in Creekmore. However, from our review of Off, we agree with appellants that Off is not basing the generation of coupons or discounts on previous transactions, but rather on the current transaction. In addition, we find that Off does not disclose entering a unique customer identification number into a point-of-sale terminal. Accordingly, we find that Off does not make up for the basic deficiencies of Creekmore. The rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off is therefore reversed.

We turn next to the rejection of claims 10, 11 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off and further in view of Tai. The examiner's position (answer, page 6) is that Creekmore in view of Off does not disclose that the response is related to the individual

customer's transaction data in shopping visits prior to the current shopping visit. To make up for this deficiency in Creekmore and Off, the examiner turns to Tai for a teaching of this feature, to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping. Appellants assert (brief, page 26), neither Creekmore nor Off "teaches or suggests entering in the customer identification code from customer information presented at the point-of-sale in a retail transaction." Appellants further assert (brief, page 26) that Tai does not teach or suggest providing a response related to the individual customer's transaction data in shopping visits prior to the current shopping visit. It is argued (id.) that Tai has nothing to do with shopping visits prior to the current shopping visit since the system merely involves the mass mailing of coupons to prospective customers. The examiner responds (answer, pages 14 and 15) that Tai tracks and measures redemption of coupons by the heaviest product purchasing regular coupon using households, analyzing the redemption characteristics of various purchase incentive offers, so that consumer promotional behavior response patterns can be predicted (col. 3, lines 18-50). Appellants respond (supp. reply brief, page 4) that "Tai does not teach or suggest generating a

customer information response at the point-of-sale during the individual customer's transaction in the retail establishment upon detection of a unique identification code of the customer as set forth in claims 10, 11, and 14."

From our review of Tai, we agree with the examiner that Tai's disclosure of analyzing redemption characteristics of the heaviest product purchasers and regular coupon using households, suggests analyzing prior redemptions, which would involve the analysis of prior transactions. However, we agree with appellants (supp. reply brief, page 4) that Tai does not disclose generating the customer information response at the point of sale during the customer's transaction upon detection of a unique identification code of the customer, as set forth in independent claims 10 and 11, but rather generates customer response at an earlier time. In addition, we find that Tai does not disclose or suggest entering a unique customer identification code at the point-of-sale, and thus does not make up for the basic deficiencies of Creekmore and Off.

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claims 10, 11 and 14. Accordingly, the rejection of claims 10, 11 and 14 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claims 7-32 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off, Tai and further in view of Bigari. The examiner's position (answer, pages 6 and 7) is that the collective teachings of Creekmore, Off and Tai do not disclose the claimed dollar amount and time of purchase. To make up for this deficiency of the prior art, the examiner (answer, pages 6 and 7) turns to Bigari for a teaching of "manipulating the dollar amount and time of purchase" . . . "in order to more effectively target consumers while shopping for promotional offers designed by marketing agencies."

Appellants assert (brief, pages 29-33) that Bigari does not make up for the deficiencies of Creekmore, Off and Tai. It is argued (brief, page 29) that the examiner does not explain how Creekmore, Off and Tai are being applied to the claims. Appellants assert (brief, page 30) that Bigari does not disclose manipulating the dollar amount and time of purchase, but rather relates to a situation where the consumer must remove some of the items from his shopping basket because the dollar amount of the goods exceeds the maximum amount of the voucher.

The examiner responds, (answer, pages 16 and 17) that Creekmore, Off and Tai are relied upon in the same fashion as they were applied to claims 10, 11 and 14. The examiner adds

that Bigari sends response signal or updated transaction data based on charge card purchases. It is additionally asserted by the examiner (answer, page 20) that the claimed customer response signal is met by Bigari because a purchaser must satisfy stored transaction data by using a dollar amount based on the maximum charge permitted, and that this maximum charge relates to prior purchases because the charge is based on a response signal from the customer. It is further asserted (id.) by the examiner that the point of purchase accumulator meets the claimed "updating transaction data."

We note at the outset that independent claims 17 and 22 do not recite manipulating the dollar amount and time of purchase. Only independent claims 27 and 30 recite updating transaction data and dollar amount of purchases associated with a unique customer identification. We make reference to our findings, supra, with respect to Creekmore, as discussed with respect to claim 8. In addition, we find that Bigari is directed to implementing credit purchases at locations which require rapid throughput of transaction events (col. 3, lines 11-15). An object of the invention is to produce credit vouchers remote from the point of purchase station (cash register) (col. 3, lines 23-25 and 33-39). A charge card reader receives a customer credit

card and transmits customer identification to a host institution. In response to an approval signal, a print signal is produced resulting in the printing of a voucher for a maximum approved charge. The voucher is indexed with both transaction data and maximum approved charge data. The customer endorses the voucher, still at the location remote from the point of purchase station. The voucher thus becomes valid for the maximum amount of the proposed charge. The card holder only then approaches the point of purchase station, and places their order. The transaction is then totaled. The attendant at the point of purchase updates the voucher for an actual update amount, which is less than or equal to the maximum purchase amount approved by the host institution (col. 4, lines 1-28).

From this disclosure of Bigari, we find that Bigari's voucher apparatus is remote from the point of purchase, just as the check verification terminal of Creekmore is near but not at the point-of-sale terminal (see also col. 6, lines 14-17 of Bigari). However, although not brought to our attention by either the examiner or appellants, we find that Bigari additionally discloses (col. 9, lines 55-61) that figures 5 through 8 [sic,7] disclose an enhanced payment voucher processing apparatus and system wherein the point of purchase register is

integrated with the payment voucher processing apparatus 10
(underlining added). From the disclosure that the payment voucher processing apparatus may either be remote from the cash register or integrated with the cash register, we find that an artisan would have been motivated to integrate the check verification terminal of Creekmore integral with the point-of-sale terminal, permitting the check approval, based on prior transactions of a customer including the dollar amounts of checks previously presented, to be sent to the point-of-sale terminal. Accordingly, although we consider Off and Tai to be cumulative to the teachings of Creekmore and Bigari, we find that the teachings of Creekmore and Bigari suggest the limitations of claim 17.

We are not persuaded by appellants' assertion (brief, page 30) that the portion of Bigari relied upon by the examiner has nothing to do with prior purchase transactions, as this feature is taught by Creekmore, as discussed, supra.

Nor are we persuaded by appellants' assertion (brief, page 32 and supp. reply brief, page 4) that the prior art does not suggest the last limitation of claim 17 which recites "'wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer

identification," because in Creekmore, verification of the check will depend on data stored in the database which indicates the dollar amount of checks given in the past, and whether any money is due the merchant from checks that have been dishonored. We add that in Creekmore, the approval of the check will include a signal to the terminal in response to the request for approval.

Nor are we persuaded by appellants' assertion (supp. reply brief, page 4) that Bigari does not teach or suggest "'wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification," as this feature is disclosed by Creekmore, where the database stores the dollar amounts of checks presented at prior transactions by customers.

From all of the above, we find that the teachings of Creekmore and Bigari establish a prima facie case of obviousness of claim 17, which has not been successfully rebutted by appellants. The rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off, Tai and Bigari is affirmed. As dependent claims 18-21 have not been separately argued, they fall with independent claim 17.

We turn next to independent claim 22. At the outset, we make reference to our findings, supra, with respect to the teachings and suggestions of Creekmore and Bigari. Appellants assert (brief, page 30) that claim 22 recites a computer implemented method which parallels claim 17, and relies on the same arguments presented for claim 17. In addition, appellants recite the last limitation of claim 22 (brief, page 32), and assert (brief, pages 32 and 33) that the subject matter referred to is not taught by Bigari. However, appellants provide no specific reasons in support of their assertion. We observe that the last limitation of claim 22, namely "'wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification,'" is met by the teachings of Creekmore and Bigari because the approval or non-approval of a customer's check depends on data stored in the database indicating the dollar amount of the check and whether any money is due to the merchant for the prior purchase. Accordingly, the rejection of independent claim 22 under 35 U.S.C. § 103(a) is affirmed. As dependent claims 23-26 have not been separately argued, they fall with independent claim 22.

We turn next to the rejection of independent claim 27. At the outset, we make reference to our findings, supra, with respect to Creekmore and Bigari. Appellants assert (brief, page 32 and 33) that Bigari does not teach the last limitation of claim 27 which recites "'circuitry responsive to the entry of said unique customer identification and said transaction data at said terminal for updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database.'" However, appellants provide no specific arguments to support their position. We observe that the last limitation of independent claim 27 is met by the teachings of Creekmore and Bigari because in Creekmore, entry of a current transaction paid for by check, along with the dollar amount of the check, after entering the customer's unique (checking account) number, reads on updating transaction data (the fact that a check was cashed that day to pay for a transaction) and a dollar amount of purchases (the dollar amount of the check which is entered into the system). Accordingly, the rejection of independent claim 27 under 35 U.S.C. § 103(a) is affirmed. As dependent claims 28 and 29 fall with claim 27, the rejection of claims 28 and 29 under 35 U.S.C. § 103(a) is affirmed.

We turn next to independent claim 30. Appellants assert (brief, pages 32 and 33) that the last limitation of claim 30, which recites "'updating transaction data and a dollar amount of purchases associated with said unique customer identification and said customer database in response to entry of said unique customer identification and said transaction data at said terminal" is not taught or suggested by Bigari. We are not persuaded by appellants' assertion because Creekmore discloses updating transaction data (entering into the database the use of a check by the customer that day to pay for a transaction and the dollar amount of purchases (entering into the system the dollar amount of the check cashed) associated with the unique customer identification (customer checking account number) in response to entry of the unique customer number (checking account number) and transaction data (the transaction of cashing a check to pay for a transaction) at the terminal. Accordingly, the rejection of claim 30 under 35 U.S.C. § 103(a) is affirmed. As dependent claims 31 and 32 have not been separately argued, they fall with independent claim 30. The rejection of claims 31 and 32 under 35 U.S.C. § 103(a) is affirmed.

We turn next to the rejection of claims 8, 9, 12 and 13 under the judicially-created doctrine of obvious-type double

patenting over claim 23 of U.S. Patent No. 5,305,196. The examiner's position (answer, page 7) is that "it would be [sic] obvious to add a terminal for a [sic] check transaction processing, database building and marketing method and system utilizing automatic check reading."

Appellants' position (brief, pages 37 and 38) is that the system defined by claim 23 does not include "means or a terminal for entering customer transaction data at the point-of-sale in the retail establishment; it does not have (1) a processor and a memory responsive to the apparatus for entering unique identification codes or (2) the terminal for entering customer transaction data for creating a database of a plurality of the retail establishment's customers' transaction data from prior shopping visits; nor does it have circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer, said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit." It is argued (brief, page 39) that the burden is on the examiner to show that the subject matter of the claims would have

been obvious from the subject matter of claim 23 of the 5,306,196 patent, and that the examiner has failed to carry that burden.

From our review of claim 23, we agree with the appellants that the examiner's assertions of what would have been an obvious addition to claim 23 are unsupported by any evidence in the record. The examiner's unsupported position is not a substitute for evidence. In the absence of any evidence establishing the obviousness of the limitations missing from claim 23, and the lack of any evidence of why an artisan would have considered the differences between claim 23 and claims 8, 9, 12 and 13, we find that the examiner has failed to establish a prima facie case of obviousness-type double patenting of claims 8, 9, 12 and 13. Accordingly, the rejection of claims 8, 9, 12 and 13 under the judicially created doctrine of obviousness-type double patenting is reversed.

We turn next to the rejection of claims 10, 11 and 14 under the judicially-created doctrine of obviousness-type double patenting as being obvious over claims 18 and 26 of U.S. Patent No. 5,201,010 in view of Tai. The examiner's position (answer, page 7) is that "[i]t would have been obvious to one skilled in the art to add the feature of a response being related to the individual customer's transaction data in shopping visits prior

to the current shopping visit in order to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping."

Appellants do not challenge the combinability of Tai with claims 18 and 26 of U.S. Patent No. 5,201,010, but rather assert (brief, pages 40 and 41) that Tai does not make up for the deficiencies of claims 18 and 26 of the '010 patent because Tai relates to prospective customers and has nothing to do with a customer's prior shopping history. It is argued (id. and supp. reply brief, page 6) that contrary to the examiner's assertions, Tai does not teach or suggest providing a response at the point of sale related to the individual customer's transaction data in shopping visits prior to the current shopping visit, upon detection of a unique identification code of the individual customer. At the outset, we make reference to our findings, supra, with respect to Tai. Although we agree with the examiner that Tai's revision of the mailing list in response to a customer's prior transaction (using a coupon that was mailed to the customer) we find that there is no teaching or suggestion in Tai of the response occurring at the point of sale. Accordingly, we find that the teachings of Tai in view of claims 18 and 26 of U.S. Patent No. 5,201,010 is insufficient to establish a prima

facie case of obviousness-type double patenting of claims 10, 11 and 14. Accordingly, the rejection of claims 10, 11 and 14 under the judicially created doctrine of obviousness-type double patenting is reversed.

We turn next to the rejection of claims 17-32 under the judicially created doctrine of obviousness-type double patenting over claims 1 and 3 of U.S. Patent No. 5,592,560. The examiner's position (answer, pages 7 and 8) is that it would have been obvious to have claimed broader subject matter than what is claimed in appellants' patent.

Appellants' position (brief, page 47) is that the examiner does not explain how the limitations of claims 17-32 would have been obvious over the subject matter of claims 1 and 3 of the '560 patent. It is argued (id.) that claim 17 includes a terminal for entering , during a transaction, the unique customer identification. In contrast, claim 1 of the '560 patent recites a terminal for entering selected indicia from identification presented by a customer in order to generate a unique identification code.

The examiner's response (answer, pages 24 and 25) is that both recitations perform the same function because a unique customer identification results from terminal data entry.

As a general principle, we agree with the examiner that the elimination of an element along with its corresponding function may be considered to have been obvious to an artisan. However, we do not find that situation to be before us as asserted by the examiner. Even though the result is that a unique customer number results, there is a big difference between a customer entering a unique customer number, and a system generating a unique customer code at a terminal. We agree with appellants that the terminal of claim 1 of the '560 patent performs a different function than the terminal of claim 17. As the examiner has failed to establish the obviousness of modifying the system of claims 1 and 3 of the '560 patent to arrive at the invention of claims 17-32, we find that the examiner has failed to establish a prima facie case of obviousness-type double patenting of claims 17-32. Accordingly, the rejection of claims 17-32 under the judicially created doctrine of obviousness-type double patenting is reversed.

NEW GROUND OF REJECTION UNDER 37 CFR \$1.196(b).

We enter the following new ground of rejection under 37 CFR \$1.196(b). Claim 33 is rejected under 35 U.S.C. § 102(b) as being anticipated by Creekmore. Creekmore discloses a computer implemented (general purpose digital computer functioning as

transaction processor 19) customer database (check cashing master file 20) comprising stored transaction data from prior point-of-sale transactions (check authorization may be determined by variable factors such as the customer's check cashing history, and the like (col. 8, lines 34-40)). In addition, Creekmore discloses that data regarding prior transactions are stored in association with an identification of the customer (applicant is assigned an account number and is issued a check cashing identification card having a magnetic stripe. The card may include the customer's checking account number, and a driver's licence number which is unique to the customer (col. 4, lines 30-47)). Transaction processor 19 verifies whether the identification card is valid (col. 6, lines 10-40)). In addition, the transaction data includes the dollar amount of purchases and the time period (the customer supplies the dollar amount of the check being presented (col. 3, lines 9 and 10; col. 11, lines 11-14); the amount authorized counters 61 indicate the quantity of each type of check which can be authorized for the customer during each N-day period, and these quantities may be determined by variable factors such as the customer's check cashing history (col. 8, lines 34-40). A record of each check cashing approval transaction handled by processor 19 during a

particular day is maintained by the daily transaction log 71, which is updated by nightly update routine 72. Information from the nightly update routine is used to generate various reports and records relating to checks which were authorized and subsequently dishonored; amounts owed to subscribing merchants for approved checks which were dishonored; merchant billing for merchant use, and various statistical reports, as desired (col. 10, lines 29-56)). From all of the above, we find that Creekmore anticipates the invention set forth in claim 33.

OBSERVATIONS AND REMARKS

Because we are primarily a board of review, we have limited the rejection under 37 CFR § 1.196(b) to a single claim. We leave it to the examiner to determine whether any or all of the remaining claims are unpatentable over the prior art, in a manner consistent with our findings as to the teachings and suggestions of the prior art, as set forth, supra.

CONCLUSION

To summarize, the decision of the examiner to reject claims 33-39 under 35 U.S.C. § 101 is reversed.

The decision of the examiner to reject claims 8, 9, 12, 13 and 33-39 under 35 U.S.C. § 102 is reversed.

The decision of the examiner to reject claims 10, 11 and 14-16 under 35 U.S.C. § 103(a) is reversed.

The decision of the examiner to reject claims 17-32 under 35 U.S.C. § 103(a) is affirmed.

The decision of the examiner to reject claims 8-14 and 17-32 under the judicially-created doctrine of obviousness-type double patenting is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

AFFIRMED-IN-PART
NEW GROUND OF REJECTION UNDER 37 CFR 1.196(b)

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